

Serial No.: 10/813,082
Group Art Unit: 3714
Examiner: Hadizodooz, B.

REMARKS

This is a response to the Office action of July 9, 2009.

Claims 1-8 are present in the application. Claim 8 is a newly added claim.

Claims 1, 2, 6 and 7 were rejected under 35 U.S.C. 102(b) as being anticipated by Parmenter (U.S. 2,859,541.) Claims 3-5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Parmenter.

Parent claims 1 and 6 have been amended to more clearly define applicant's invention over the Parmenter patent.

Parent claim 1 has been amended to state that the "designated pairs of responses" in line 1 are responses to a "related designated pair" of questions. Basis for this amendment is set out in the specification on page 1, in the first sentence under "Background and Field of the Invention", and also in lines 16 and 17 of page 1. Also, claim 1 has been amended to recite "said template comprising means for identifying a series of paired locations thereon...."; for example, the paired locations may be identified by different lines, or different shapes or symbols for identifying one pair separately from another pair, as shown in FIG.1.

Parent claim 6 has been amended to indicate evaluating designated pairs of responses to "related pairs" of questions. This amendment is supported at page 1, lines 16 and 17. Also, claim 6 has been further amended to more particularly define the

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step of "following a pathway for identifying pairs of responses to a plurality of related pairs of questions, and evaluating said pairs of responses to said related pairs of questions." No such teaching or suggestion is apparent in the Parmenter patent.

Regarding Claim 1, the Office action states that "Parmenter discloses a template for evaluating and scoring *designated pairs of responses* to a series of questions, said template comprising a *series of paired locations* thereon, a first set of said [paired] locations being linked by indicia on said template, a pathway leading from said first set of [paired] locations to at least a second set of [paired] locations, said pathway being shown by said indicia for leading a user from said first set to said second set of [paired] locations, each of said [paired] locations having means for allowing viewing through said templates."

[italics added] The office action refers to Col. 1, 28-41, Col. 4, 19-29 and Figure 4 of Parmenter's patent. First, Col. 1, 36-38 states, "...a single stencil will permit the examiner simultaneously to correct answers inserted by the examinee on different surfaces of the examination paper..." In complete contrast to Claim 1, Parmenter has described a process for simultaneously scoring the *independent* responses to a series of questions located on two or more answer sheets. The answers to which Parmenter refers are *independent* of one another. Parmenter does not disclose and/or make any reference to designated *pairs* of responses. Second, Col. 4, 20-22 states, "...the top face of the

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stencil may carry lines 19 extending from each correct answer location to another to form counting eye paths for the examiner...." In complete contrast to Claim 1, each of the answers referred to by Parmenter is scored independently, and the lines referred to by Parmenter are linking a series of single, independent responses, not designated pairs of responses. This distinction is clearly evident in Figure 4 wherein there are two distinct lines that connect a series of independent locations, but there are no designated pairs of locations, and no pathway which connects a series of paired locations. It is evident that Claim 1 was not anticipated by Parmenter.

Regarding Claim 2, the Office action states, "Parmenter further discloses a template as defined in claim 1, wherein said indicia comprises a series of lines connecting the sets together (See figure 5 and Col. 4, 19-29)" As stated in the previous paragraph, the lines referred to by Parmenter are linking a series of single, independent responses and not sets of responses as suggested by the Office action. The Office action makes reference to Fig. 5 which appears to have no bearing on the argument. Assuming that the Office action intended to reference Fig. 4, once again, a review of Fig. 4 clearly shows two lines that are linking a series of single, independent responses, not designated pairs of responses. It is evident that Claim 2 was not anticipated by Parmenter.

Regarding Claim 3, the Office action states, "Parmenter

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discloses that the indicia comprise a series of solid lines connecting the sets together. Parmenter does not specifically disclose a series of alternating solid and broken lines on the indicia. However, the only difference between the prior art and the claimed invention is printed matter that is not functionally related to the product. Moreover, the content of the printed matter will not distinguish the claimed invention from the prior art. See *re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). First, Parmenter makes no mention of connecting any sets together. Parmenter does not disclose a relationship between any of the independent answers shown in Fig. 4. The series of alternating solid and broken lines as disclosed in Claim 3 is, in fact, functionally related to the product inasmuch as said lines are used to clearly identify designated pairs of locations. The identification of designated pairs of locations is fundamental to the claimed invention.

Regarding Claims 4 and 5, the Office action refers to Col. 4, 19-29. First, Col. 4, 23-24 states, "In addition, in cases where the questions are arranged in several group types and it is desired to score each group, ..." [italics added]. Once again, Parmenter does not make reference to designated pairs of responses. Parmenter does disclose the use of colored lines so that "the answer groups are readily identifiable." It is important to note that the use of colored lines for this purpose is only possible "where the questions are [pre-] arranged in several

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group types." This is a significant difference between the prior art and the current invention. As stated in the *Background and Field of the Invention* of the current invention, "This invention relates to a method for scoring designated pairs of responses that are located randomly across a master answer sheet [not pre-arranged groups as disclosed by Parmenter] and it precludes the need to search for and transfer said pairs of responses onto another sheet for scoring." It is evident that Parmeter did not anticipate the current invention. The current invention addresses a problem that did not even exist at the time of Parmeter's invention due to the nature of testing at that point in time.

Secondly, there is, in fact, a significant advantage and a functional use in the application of different geometric shapes to identify the *designated pairs* of responses. The detailed description of the current invention does acknowledge that each pair of critical responses can be joined to another pair of responses by a different form of indicia, including different colored lines. But without the use of geometric shapes, or another form of identification, the designated pairs of responses would not be apparent. For example, assume a series of locations numbered from 1 to 20, with each location denoted only by a circle and joined together by alternating red and blue lines. Assume locations 9 and 10 are joined by a red line, 10 and 11 are joined by a blue line, 11 and 12 are joined by a red line, 12 and 13 are joined by a blue line, etc. Without the use of paired

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geometric shapes (or another form of identification), it would be impossible to know whether or not the designated pair is 9 and 10 or 10 and 11. Likewise, it would be impossible to know if the next designated pair is 11 and 12 or 12 and 13. Now consider locations 9 and 10 designated by two circles and joined by a red line, 11 and 12 designated by two squares and joined by a blue line, 13 and 14 designated by two squares and joined by a red line, etc. Now it becomes clear that 9 and 10 are a designated pair, 11 and 12 are a designated pair, and 13 and 14 are a designated pair. The alternating lines, albeit broken and solid lines or two different colors, serve to reinforce the identification of the designated pairs and reduce the chances of making a mistake. Parmenter does not disclose the presence of any paired responses and does not disclose a continuous line that joins a series of paired responses. It is evident that Parmenter does not teach or suggest the presently claimed invention.

Regarding Claims 6 and 7, and new claim 8, the Office action states, "Parmenter further discloses a method for evaluating the pairs of responses to a series of questions by positioning the template upon an answer sheet and following a pathway wherein said pathway is comprised of a continuous line (see Figure 4)." Once again the Office action makes reference to pairs of responses, when there are no pairs of responses. A review of Fig. 4 clearly shows two distinct lines that are linking a series of independent responses. There is no continuous line that is

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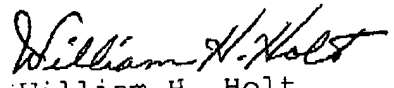
linking together a series of paired responses. It is evident that Parmenter does not teach or suggest the limitations in these claims.

In view of the foregoing amendments, discussions and agreements reached at the interview on April 16, 2009, and the explanations given in applicant's previous responses, the claims now define over all of the cited prior art of record. It is believed that the application is now in condition for allowance of claims 1-8 and such action by the Examiner is courteously solicited.

In the event that the Examiner has any doubts concerning patentability of the claims, applicant would appreciate the opportunity of having either a personal interview or a telephone conference to expedite allowance.

Respectfully submitted,

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